

REMARKS

Favorable reconsideration is respectfully requested in light of the following comments. Claims 1-11 and 13-23 remain pending.

§ 103 Rejections

Claims 1-11, 13, 14, 21 and 22 are rejected under 35 U.S.C. § 103(a) as unpatentable over EP 457 607, in view of UK 2,326,727. Applicants respectfully traverse the rejection. In order to establish a proper *prima facie* obviousness rejection, it is necessary, among other requirements, to provide motivation to combine the references as suggested by the Examiner. At a minimum, this requirement has not been met. Applicants do not concede that the Examiner has met the other requirements of a *prima facie* obviousness rejection.

The Examiner relies upon the secondary reference, UK 2,326,727, to suggest forming the first alignment layer on a polarizing element, which is a claimed element not disclosed by the primary reference. However, there is no reasonable or appropriate motivation provided to make such a combination.

In originally asserting the obviousness of combining these two references (in the Office Action mailed November 16, 2005), the Examiner stated that it would "...have been obvious to one of ordinary skill in this art to modify the method of the primary reference by forming additional polarizing and alignment layers on the rotator film disclosed therein as generally taught by British -727 dependent on the exact purpose desired for the rotator...". This is not correct, and is not an appropriate motivation.

In particular, in combining these references, the claimed invention is not met by simply adding layers to the film disclosed by the primary reference. The primary reference describes forming an optical rotator by forming an alignment film layer on a light transmitting base and then forming a liquid crystal layer on the alignment film layer. Simply adding layers, as suggested by the Examiner, will not meet the claimed invention. Rather, the Examiner actually appears to be suggesting that the light transmitting base disclosed by the primary reference be replaced by a polarizing element disclosed by the secondary reference.

However, no motivation has been provided to make such a substitution. Even though the primary reference discloses that their optical rotator could be used in conjunction with another

optical element such as a polarizer, this is not the same as suggesting that their optical rotator be significantly altered by incorporating additional elements. There simply is no motivation provided within the primary reference to make such a substantial modification.

Moreover, the secondary reference also fails to provide appropriate motivation to make such a substantial modification. While the secondary reference does disclose a variety of layers sandwiching a liquid crystal layer, the secondary reference is directed to a significantly different structure designed to form a significantly different function. The secondary reference is directed, in particular, to making a light modulator that requires, as previously discussed, two polarizer layers. That the secondary reference is directed to a much different purpose is evidenced, for example, by the fact that the secondary reference describes a liquid crystal material that is significantly different from the fixed liquid crystal material disclosed by the primary reference. Furthermore, fixing the liquid crystal material of the secondary reference would destroy its function as an active light modulator. The secondary reference provides no appropriate motivation to modify the primary reference as suggested by the Examiner.

In summary, neither reference has provided appropriate motivation to one of ordinary skill in the art to modify and combine the references as suggested by the Examiner to obtain the claimed invention. Consequently, the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

Claims 15-20 and 23 are rejected under 35 U.S.C. § 103(a) as unpatentable over EP 457 607, in view of view of UK 2,326,727, and Sharp et al., U.S. Patent No. 5,999,240. Applicants respectfully traverse the rejection. EP 457 607 and UK 2,326,727 are distinguished above as failing to describe or suggest a method of forming a film that includes a method step of forming a first alignment layer on a polarizing element. Sharp et al. are not believed to remedy this shortcoming, by disclosing the missing claimed element and/or by providing the required motivation or suggestion to modify the cited references in order to arrive at the claimed invention. Thus, the *prima facie* obviousness rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

CONCLUSION

In view of the above, Applicant respectfully requests withdrawal of the rejections and allowance of the claims. Prompt passage to issue is earnestly solicited. Should the Examiner feel a telephone interview would be helpful in advancing this case to allowance, Applicant invites the Examiner to contact their representative at the number listed below.

Please continue to transmit all correspondence to:

Anna A. Kobilansky, Esq.
3M Innovative Properties Company
PO Box 33427
St. Paul, MN 55133-3427

Respectfully Submitted,

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Brian C. Whipps, Reg. No. 43,261
BCW:KCH

CROMPTON,SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, Minnesota 55403-2420
Telephone: (612) 677-9050
Facsimile: (612) 359-9349